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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,218	03/30/2000	Paul Beinat	PMS-258	8960
7590 09/15/2005				
CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112		EXAMINER FRENEL, VANEL		
		ART UNIT PAPER NUMBER		
		3626		

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/539,218

Applicant(s)

BEINAT ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Handwritten signature or mark.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 06/23/05. Claims 1, 3, 12-16, 18, 20-21, 25-26, 28, 30-31, 33, 35, 47, 49, 51-53, 55, 57, 60, 67, 69, 71, 74-76 have been amended. Claims 2, 17, 32, 70 have been canceled. Claims 1, 3-16, 18-31, 33-69 and 71-86 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 77-78 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

(A) The basis of this rejection is set forth in a two –prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 77-78 recite "a method for modeling medical conditions and impairments affecting a person " but do not clearly and definitely utilize any technological device (i.e., "a computer-medium" or "a computer device" in performing the various claimed steps.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claims 77-78 as a whole are directed to selecting a said profile's corresponding to each said transient medical condition.

As such, this invention produces a useful, concrete, and tangible results as relating said selected profile's time dimension to the occurrence of its said transient medical condition.

Claims 77-78 do not recite any application or use of the technological arts, and thus equally rejected under 35 U.S.C 101.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 12-16, 18, 20-21, 25-26, 28, 30-31, 33, 35, 47, 49, 51-53, 55, 57, 60, 67, 69, 71, 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeTore et al (4,975,840), Seare et al (6,223,164) in view of Joao (6,283,761) for substantially the same reasons given in the previous Office Action. Further reasons will be addressed hereinbelow.

(A) Claim 1 has been amended to recite the feature of "inputting into a computer", "generating and outputting on an output device an assessment of the impact of said medical conditions on said person, wherein said assessment is based on said profiles related to said medical conditions at step (d).

However, this feature is known in the art, as evidenced by Joao. In particular, Joao suggests of "inputting into a computer", "generating and outputting on an output device an assessment of the impact of said medical conditions on said person, wherein said assessment is based on said profiles related to said medical conditions (See Joao, Col.4, lines 11-58; Col.5, lines 7-45).

(B) Claim 16 has been amended to recite the feature of "inputting into a computer" "and" and "generating and outputting said least date on an output device" (See Joao, Col.4, lines 11-58).

(C) Claim 31 has been amended to recite the feature of "inputting into a computer", "inputting into a computer", "and", "generating and outputting on an output device an assessment of the impact of said medical conditions on said person, wherein said

assessment is based on said combined severity value (See Joao, Col.4, lines 11-58; Col.5, lines 7-45).

(D) Claim 69 has been amended to recite the feature of "inputting into a computer", "Inputting into a computer" and "generating and outputting an assessment of the impact of said medical conditions on said person (See Joao, Col.30, lines 9-21), wherein said assessment is based on said whole body severity value determined at step (e) and on any said severity values provided at steps (f)-(l) related to said medical conditions at step (d) (See Joao, Col.27, lines 9-30).

(E) Claims 3, 12-15, 18, 20-21, 25-26, 28, 30, 33, 35, 47, 49, 51-53, 55, 57, 60, 67, 71, 74-76 have been amended to only change their dependencies. Therefore the claims have been rejected under the same rationale in the previous Office Action, and incorporated herein.

(F) Claims 4-11, 13, 19, 22-24, 27, 29, 34, 36-46, 50, 54, 56, 58-59, 62-66, 68, 72-73, 77-86 have not been amended are therefore rejected under the same rationale given in the previous Office Action, and incorporated herein.

Response to Arguments

6. Applicant's arguments filed on 06/23/05 with respect to claims 1, 3, 12-16, 18, 20-21, 25-26, 28, 30-31, 33, 35, 47, 49, 51-53, 55, 57, 60, 67, 69, 71, 74-76 have been

fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 06/23/05.

(A) At pages 31-36 of the 06/23/05 response, Applicant argues the followings:

(1) The rejection under 35 U.S.C. 101.

(2) DeTore, Seare and Joao do not describe, suggest either alone or in combination the particular feature of the system invention which uses predictive recovery over the time (level of dysfunction over a progressive timeline) from time of injury for each body part and sub-part, and what impact that might have on the claimant's quality of life, time line for recovery, the monetary value of current and future pain and suffering and loss of amenities of life and degree of possible recovery.

(3) There is no suggestion or requirement of providing and maintaining information concerning the (dysfunction of individual body parts, (2) estimates of their progressive recovery rate over time in the future, or (3) representation of injury and estimate of future recovery as dysfunction levels over time.

(4) Neither DeTore nor Joao describe or suggest this feature, either alone or in combination with Seare.

(B) In response, it is respectfully submitted that Applicant takes the cited passage from the *State Street* decision out of context. In particular, the passage relied upon by Applicant appears to directed to an explanation on why the application of a particular test, the Freeman-Walter-Abele test, for determining statutory subject matter was misleading. Note the quoted passage in its entirety, as given hereinbelow for Applicant's convenience:

"After *Diehr* and *Chakrabarty*, the Freeman-Walter-Abele test has little, if any, applicability to determining the presence of statutory subject matter. As we pointed out in *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1557, application of the test could be misleading, because a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea is patentable subject matter even though a law of nature, natural phenomenon, or abstract idea would not, by itself, be entitled to such protection."

As such, since no such test was applied to Applicant's claimed invention, the cited passage has no relevance to the issues at hand.

Further, it is noted that the Examiner rejection was not based on the fact the claimed process is NOT useful, tangible, or concrete, nor that claimed process lacks a practical application, *per se*. Rather, the basis of the Examiner's rejection was that the recited claims were not directed to a practical application in the technological arts. With regard to this issue, it is noted that Applicant's presently recited claims do not even rise the level of the claims under review by the Federal Circuit in the *State Street Bank* decision, which clearly and explicitly recite a practical application in the technological arts. Note, for example, the format and language of claim 1 in the *State Street Bank* decision, provided hereinbelow:

1. A data processing system for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:

(a) computer processor means [a personal computer including a CPU] for processing data;

(b) storage means [a data disk] for storing data on a storage medium;

(c) first means [an arithmetic logic circuit configured to prepare the data disk to magnetically store selected data] for initializing the storage medium;

(d) second means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases or decreases based on specific input, allocate the results on a percentage basis, and store the output in a separate file] for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds, [sic, funds'] assets and for allocating the percentage share that each fund holds in the portfolio;

(e) third means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund;

(f) fourth means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund; and

(g) fifth means [an arithmetic logic circuit configured to retrieve information from specific files, calculate that information on an aggregate basis and store the output in a separate file] for processing data regarding aggregate year-end income, expenses, and capital gain or loss for the portfolio and each of the funds.

As such, it is respectfully submitted that Applicant's reliance on the *State Street Bank* decision is not persuasive, as Applicant's presently recited claims clearly lack a practical application in the technological arts in a manner consistent with the claims reviewed by the Federal Circuit in their decision.

Moreover, the Examiner is concerned that Applicant apparently ignores the mandate of other court decision that clearly support the Examiner's position. For example, the court in *In re Toma* stated: " 'technological' or 'useful' arts inquiry must focus on whether claimed subject matter, for example, method of operating machine to translate, is statutory, not on whether product of claimed subject matter, for example, translated text, is statutory, not on whether prior art that claimed subject matter purports to replace, for example, translation by human mind, is statutory, and not on whether claimed subject matter is presently perceived to be improvement over prior art, for example, whether it 'enhances' operation of machine; this was law prior to *Gottschalk v. Benson*, 175 USPQ 673, and was not changed by *Benson*." (emphasis added) 197 USPQ 852, 853 (CCPA 1978). In *In re Musgrave*, 167 USPQ 280 (CCPA 1970), it was held that " all that is necessary to make a sequence of operational steps a statutory 'process' within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with Constitutional purpose to promote progress of "useful arts" (emphasis

added).

In sum, it is respectfully submitted that the Examiner's rejection of the claims under 35 USC 101 is indeed proper and should be maintained for at least the reasons given above and the guidance of appropriate case law.

(C) With respect to Applicant first argument, Examiner respectfully Joao discloses "For example, the present invention can be utilized in the following manner. A patient scheduled for surgery on a certain body part (i.e. left ankle) may enter the hospital. Due to a hospital clerical error, the right ankle is noted to be operated on. Prior to the surgery, the surgeon may access the central processing computer 10, via a provider communication device 20 located in the operating room, and/or another location in the hospital, in order to verify the procedure to be performed. In response thereto, the central processing computer 10 will transmit a message that it is the left ankle which is to be operated on. Thereafter, the surgeon can investigate the situation and ensure that the correct and prescribed surgery and/or procedure is performed. Once the surgery is completed, the patient's record will be updated accordingly. While a surgical procedure is described, it is important to note that any treatment, procedure, etc., which can be performed by any healthcare professional described herein, and/or in any healthcare field described herein, can be verified in the above-described manner. In this manner, the present invention can be utilized to pre-screen subsequent and/or follow-up treatments and/or procedures so as to prevent healthcare mistakes and/or mishaps"

which correspond to Applicant's claimed feature (See Joao, Col.27, lines 9-30).

Therefore, Applicant's arguments are not persuasive and the rejection is made final.

(D) With respect to Applicant second argument, Examiner respectfully submits that Joao suggests "a method for providing healthcare information which can be utilized to find and/or locate supplies, body organ, blood, medications, and/or any other goods, products, and/or supplies, etc." which correspond to Applicant's claimed feature (See Joao, Col.10, lines 3-29). Therefore, Applicant's arguments are non- persuasive and the rejection is made final.

(D) With respect to Applicant third argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445,24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the previous Office Action). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the

applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the DeTore, Seare and Joao references, separately, and in

a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Joao reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
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August 31, 2005


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